THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JUDITH A. BURTON
and
MARY B. McKENZIE

_____

Appeal No. 96-4085
Application 08/341,837[1]

_____

ON BRIEF

_____

Before ABRAMS, FRANKFORT and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

[1] Application for patent filed November 18, 1994. According to appellants, the application is a continuation of Application 08/153,224, filed November 15, 1993, abandoned.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 4, 8 through 13, 19 through 23 and 28, which are all of the claims remaining in this application. Claims 1, 3, 5, 6, 7, 14 through 18 and 24 through 27 have been canceled.

Appellants' invention relates to an aquatic floating device constructed for comfortable, relaxed flotation in a variety of modes, and for compact handling and storage. Appellants' invention also addresses a method of floatation using the above-noted floating device. Claims 21 and 22 are representative of the subject matter on appeal and a copy of those claims, as they appear in Appendix A to appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness of the claimed subject matter are:

Pruden	689,020	Dec. 17, 1901
Hull	5,049,102	Sept. 17, 1991

Ciolino et al. (Ciolino '314)	5,149,314	Sept. 22, 1992
Johnson et al. (Johnson) (British application)	2,075,924	Nov. 25, 1981

Claims 2, 4, 8 through 12, 21 through 23 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Ciolino.

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Ciolino as applied to claim 22 above, and further in view of Pruden.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Ciolino as applied to claim 22 above, and further in view of Hull.

Reference is made to the examiner's answer (Paper No. 18, mailed June 20, 1996) for the examiner's full reasoning in support of the above-noted rejections and to appellants' substitute brief (Paper No. 17, filed May 28, 1996) for appellants' arguments thereagainst.

OPINION

As a preliminary matter, we note that on page 5 of the brief appellants have set forth that claims 8 through 12 stand or fall together with independent claim 22, while each of the other claims on appeal "do not stand or fall together."

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellants' specification and claims, the applied prior art references and the respective positions advanced by appellants and the examiner. As a consequence of our review, we have come to the conclusion, for the reasons which follow, that the examiner's rejections of the appealed claims under 35 U.S.C. § 103 will not be sustained.

Looking to the examiner's rejection of claims 2, 4, 8 through 12, 21 through 23 and 28 under 35 U.S.C. § 103 based on Johnson and Ciolino, we note that independent claim 22 is directed to the flotation apparatus, while independent claim 21 is directed to a flotation method using such apparatus. On page 5 of the brief, appellants urge that

> Johnson et al has no float section which is sized and adapted to underlie the head and shoulders of a user.
>
> In addition, claim 22 calls for a second float section which is sized and adapted to underlie a femoral portion of the legs of the user. This second float section is "shorter than the first float section".
>
> In the buoyancy means of Johnson et al, the two floats 11 and 12 appear from Fig. 6 to be of about the same length. The flotation apparatus of claim 22 also includes a connecting section which is longer than "either of said float sections" and the connecting section is sized and adapted "to extend from a mid back region of the user to a femoral region of the user". As shown in Fig. 5b of Johnson et al, the connecting member 14 does not extend from a mid back region of the user, but rather underlies the user's buttocks.

On page 6 of the brief, appellants urge, with regard to Ciolino and the examiner's combination of the applied references, that

> Ciolino's float is very different from Appellants' in that, for example, the hinge 3 is shorter than both of the float sections 1 and 2, the hinge 3 does not extend from a mid back region to a femoral region and the float of Ciolino does not terminate at the distal end of the float section 2 as required by claim 22.
>
> Given these significant differences, there is no motivation provided to one of ordinary skill in the art to modify Johnson et al only

> with respect to head support, without also adopting the relatively short connecting section, or the third float section 5 of Ciolino. To do this would amount to attempted reconstruction of Appellants' device by picking and choosing random features from the prior art using hindsight and Appellants' own disclosure as a guide.

While it is true, as seen in Figures 1, 2, 5a and 5b of Johnson, that the first float section (11) is not sized to underlie the head and shoulders of a user, we must agree with the examiner that it would have been obvious to one of ordinary skill in the art to so size the float section (11) and thereby provide added comfort to the user and also assist in keeping the head and ears of the user out of the water during use of the flotation device, as suggested in Ciolino. Ciolino (col. 3, lines 65-68) specifically notes that the general shape of the first float section (1) therein is long enough so that "in use it will extend from the user's head or neck to the lower back area." In comparing Figures 5a, 5b of Johnson and Figures 4A, 4B, 5A, 5B of Ciolino, we consider that it would have been readily apparent to the artisan that head and neck support in Johnson would be needed

to enhance the comfort of the flotation device therein, especially when using the device as shown in Figure 5b.

As to the requirement of claim 22 that the second float section have a length which is "shorter than the first float section," we observe that in following the teachings of Ciolino to extend the length of the first float section (11) of Johnson so as to enhance the comfort of the flotation device therein by supporting the head and neck of a user, it would logically follow that the second float section (12) would then be shorter than the first float section, as is also depicted in Ciolino (e.g., Figures 5A, 5B).

Where we part company with the examiner is in the evaluation of the claimed size of the connecting section relative to the float sections, i.e, the requirements in appellants' claims that the connecting section must be "longer than either of said float sections," and that the connecting section be "sized and adapted to extend from a mid back region of the user to a femoral region of the user and to terminate at such femoral region." In this regard, we must agree with appellants' argument

that neither Johnson nor Ciolino teaches or suggests a connecting section that would be responsive to these particular claim limitations. The examiner's position (answer, page 5) that the "references teach that the dimensions of the float sections are obvious matters of design choice," is unavailing. Appellants' specification makes it clear in a number of different places that the relative dimensions of the connecting section vis-à-vis the float sections is an "important feature of the invention" and "particularly advantageous" (see, e.g., specification, pages 3-4)

because it permits the flotation apparatus to be used in a variety of modes (including chair and sling configurations), to be folded into a very compact configuration, and it permits the user's head and neck to remain above the water even though much of the user's body will be immersed due to its support only by the long and less buoyant connecting section. Representative dimensions for the respective float sections and the connecting section are set forth in the paragraph bridging pages 8-9 of appellants' specification.

Under the circumstances here, we consider that it is inappropriate for the examiner to merely invoke design choice as

a means for supplying deficiencies in the applied references, given that appellants have in their specification indicated that the particular sizing relationships solve certain problems and provide key features to the invention therein. Like appellants, we find that the examiner's combination of Johnson and Ciolino is based on hindsight reasoning derived only from appellants' disclosure and not on the fair teachings of the prior art references themselves.

Based on the foregoing, we will not sustain the examiner's rejection of claims 2, 4, 8 through 12, 21 through 23 and 28 under 35 U.S.C. § 103 based on Johnson and Ciolino.[2]

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[2] On page 7 of the answer, the examiner has expressed the view that

> since individuals come in different sizes, terms relating to the size of a user are not particularly specific. Thus, a float "sized and adapted" to fit one individual in a particular manner will not fit a second individual in the same manner, if the second individual is shaped and sized differently. It is conceivable that the arrangement shown by Johnson et al, for example, could fit some individuals in the manner recited in the claim.

To the extent that this reasoning appears to raise an issue under 35 U.S.C. § 112, second paragraph, we note that no such rejection is before us for review in this appeal. If the examiner considers that such a rejection might be appropriate, then the examiner should positively so indicate on the record.

We have additionally reviewed the teachings of Pruden and Hull applied by the examiner against dependent claims 13, 19 and 20. However, we find nothing in these references which would supply that which we have found lacking in the basic combination of Johnson and Ciolino. Accordingly, the rejections of claims 13, 19 and 20 under 35 U.S.C. § 103 will also not be sustained.

The decision of the examiner rejecting claims 2, 4, 8 through 13, 19 through 23 and 28 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)
Administrative Patent Judge)
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)
) BOARD OF PATENT
CHARLES E. FRANKFORT) APPEALS AND
Administrative Patent Judge) INTERFERENCES
)
)
)

LAWRENCE J. STAAB)
Administrative Patent Judge)

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APPENDED CLAIMS

21. A flotation method comprising:

lying in the water on a flotation apparatus with the flotation apparatus oriented with respect to the user's body such that the head and shoulders of the user are on a first float section, a portion of the legs of the user which is above the knees of the user is on a second float section, the legs of the user beneath the knees are unsupported by the flotation apparatus and a flexible connecting section which is of less buoyancy than the first and second float sections and which joins the first and second float sections underlies the user from a mid back region of the user to a femoral region of the user whereby the flexible connecting section allows the user's body from the mid back region to the femoral region to be in the water.

22. A flotation apparatus, comprising:

a first float section sized and adapted to underlie the head and shoulders of a user;

a second float section sized and adapted to underlie a femoral portion of the legs of the user and being shorter than the first float section; and

a connecting section formed of a flexible material and being less buoyant than the first and second float sections, said connecting section extending between and joining said first and second float sections, said connecting section being longer than either of said float sections, said connecting section being sized and adapted to extend from a mid back region of the user to a femoral region of the user and to terminate at such femoral region, and the flotation apparatus terminating at a distal end of the second float section.